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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/534,006

05/05/2005

Ronan Dif

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05/08/2009

Baker Donelson Bearman Caldwell & Berkowitz PC

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EXAMINER

YANG, JIE

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

05/08/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/534,006	Applicant(s) DIF ET AL.	
	Examiner JIE YANG	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21, 23-25 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) 11-21, 23-25 and 27-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/25/2009 has been entered.

Status of the Claims

Claim 1 has been amended; claims 22 and 26 are cancelled; claims 11-21, 23-25 and 27-32 are withdrawn from consideration as non-elected claims; and claims 1-10, 33 and 34 remain in examination.

Status of the Previous Rejection

The previous rejection of claim 22 is withdrawn because the claim has been cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the instant case, the limitation of “...**any one of claim 1**” renders the claim 5 being indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cho (US 4,988,394, thereafter US'394).

US'394 is applied to claims 1-6, and 8 for the same reason as stated in the office actions of 4/24/2008 and 10/28/2008.

Regarding the amended limitation of “consisting essentially of” in the instant claims 1, the transitional language “consisting essentially of” will be constructed as equivalent to “comprising.” See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of “consisting essentially of,” applicant has the burden of showing

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that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See MPEP 2111.03. In the instant case, the applicant has not shown that the introduction of the additional steps of Cho would materially change the characteristics of applicant's invention.

Claims 7, 8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US'394 in view of Mohr et al (WO 92-03586, thereafter WO'586).

US'394 in view of WO'586 is applied to claims 7, 8, and 10 for the same reason as stated in the office actions of 4/24/2008 and 10/28/2008.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over US'394 in view of WO'586 and Saunders (NPL: The modeling of stable and metastable phase formation in multi-component A—alloys, in "Aluminum alloy, their physical and mechanical properties, Proc. ICAA9", eds. J.F.Nie et al, (Inst. Materials Engineering Australia, Melbourn, 2004) pp.96-106, thereafter, NPL-1).

US'394 in view of WO'586 and NPL-1 is applied to claim 9 for the same reason as stated in the office actions of 4/24/2008 and 10/28/2008.

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Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over US'394 in view of Wyatt-Mair et al (US 5,894,879, thereafter US'879).

US'394 in view of US'879 is applied to claims 33 and 34 for the same reason as stated in the office actions of 4/24/2008 and 10/28/2008.

Response to Arguments

Applicant's arguments, see "applicant arguments/remarks", filed 7/23/2008, with respect to the rejection(s) of claim(s) under 35 U.S.C. 103(a) have been fully considered but they are not persuasive.

In the remark, the Applicants argue that Cho (US'394) does not teach a simplified process which would reduce cost in the same manner as the instant invention. To the contrary, Cho teaches a process with additional steps compared to the usual process, which will increase cost (refer to the remark filed on 7/23/2008). The applicants amended claim 1 to change the transitional phrase from "comprising" to "consisting essentially of". Therefore the extra steps of Cho (US'394) are not covered by the claims.

In response, as discussed above, the transitional language "consisting essentially of" will be constructed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re

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De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See MPEP 2111.03. As pointed out in the previous office action marked 4/24/2008 and 10/28/2008, Cho (US'394) teaches a manufacturing method with similar alloy composition, treated by similar homogenization, hot working, worm working, and cold working process for the similar uncrystallized product as recited in the instant invention. All the major compositions of alloy and major working steps taught by US'394 overlap the compositions and the major working steps as recited in the instant claim 1, which is a prima facie case of obviousness. SEE MPEP 2144.05 I.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jie Yang whose telephone number is 571-2701884. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-2721244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JY

/Roy King/
Supervisory Patent Examiner, Art Unit 1793